

UNITED STATES DISTRICT COURT
DISTRICT OF MINNESOTA

Drent Goebel North America, Inc.
as successor in interest to RDP
Marathon, Inc.,

P. 7,011,020

Plaintiff,

v.

MEMORANDUM OPINION
AND ORDER
Civil No. 07-4110 (MJD/AJB)

Precision Press, Inc.

Defendant.

Mark P. Hodkinson and Lewis A. Remele, Jr., Bassford Remele, A Professional Association and Keith D. Parr and James T. Peterka, Locke Lord Bissell & Liddell LLP and Robert P. Conlon, Walker Wilcox Matousek LLP for and on behalf of Plaintiff.

James G. Bullard, Leonard, Street and Deinard, and Thomas P. Battistoni and Patricia J. Thompson, Schiff Hardin, LLP for and on behalf of Defendant.

This matter is before the Court upon Defendant's Motion to Dismiss pursuant to Fed. R. Civ. P. 12 (b)(1) and (6) on the grounds that subject matter jurisdiction is lacking and the Complaint fails to state a claim.

Plaintiff Drent Goebel North America, Inc. ("Drent Goebel") is engaged in the business of developing, manufacturing and marketing web offset printing

presses. Drent Goebel is the owner of U.S. Patent No. 7,011,022 ("the '022 patent"). This patent contains claims that are directed to an offset printing press comprising, *inter alia*, removable plate and blanket cylinders and substitutable replacement cylinders. Defendant Precision Press, Inc. ("Precision Press") is engaged in the printing business.

In its Complaint, Drent Goebel alleges that in late 2006 and early 2007, it became aware that Precision Press planned to purchase certain offset printing equipment from Muller Martini. Complaint ¶ 11. In a letter dated May 31, 2007, Drent Goebel informed Precision Press that any use of equipment covered by the claims of the '022 patent would constitute infringement, and requested that Precision Press make the equipment available for inspection prior to installation.

Id.

Precision Press responded by letter dated June 18, 2007, advising Drent Goebel that Precision Press did not believe that it infringed the '022 patent. Id. ¶ 12. Precision Press later advised Drent Goebel that it would not permit inspection of the equipment in question. Id. ¶ 13.

Drent Goebel further asserts that it "believes the equipment in question infringes one or more claims of its '022 patent but cannot determine with

certainty which of the 13 claims of the '022 patent are infringed until it has an opportunity to inspect the equipment." Id. ¶ 14.

Precision Press asserts that it inquired of Drent Goebel the basis upon which it claimed infringement, as did the equipment's manufacturer, Muller Martini. Thompson Declaration, Ex. 2, Letter dated August 18, 2007 to Keith Parr. Precision Press asserts that Drent Goebel did not respond to their inquiries, but instead filed this action in which it conceded that it cannot determine with certainty which of the 13 claims of the '022 patent are infringed until it can obtain discovery. Id. ¶ 14.

Instead of bringing a patent infringement claim under the patent laws, Drent Goebel has asserted a claim under the Declaratory Judgment Act, seeking declaratory relief that Precision Press' use of offset printing equipment it purchased from Muller Martini infringes the '022 patent.

Standard for Dismissal under Rule 12 (b)(1)

The Declaratory Judgment Act requires that there be an actual case or controversy before a court can declare the legal relationship between the parties. 28 U.S.C. § 2201(a). "The burden of establishing jurisdiction in the district court lies with the party seeking to invoke the court's jurisdiction." Cedars-Sinai Med.

Ctr. v. Watkins, 11 F.3d 1573, 1583 (Fed. Cir. 1993). If subject matter jurisdiction is challenged based on the sufficiency of the pleadings, then the allegations are taken as true and construed in the light most favorable to the nonmovant. Id. If subject matter jurisdiction is challenged by the movant who denies or controverts the allegations in the complaint, then the allegations in the complaint are not controlling. Id. Those facts that are controverted are subject to fact-finding by the district court. Id.

By this motion, Precision Press challenges the sufficiency of the Complaint, asserting the allegations in the Complaint do not establish the existence of an actual case or controversy. In fact, the allegations include Drent Goebel's concession that it must inspect the equipment at issue to "determine with certainty which of the 13 claims of the '022 patent are infringed." Complaint ¶ 14. In addition, Drent Goebel does not allege any basis for a reasonable suspicion that the accused printing press infringes of the '022 patent. Precision Press asserts that in actuality, the Complaint at issue is one seeking discovery.

A claim seeking discovery in order to determine whether infringement exists lacks any independent basis for subject matter jurisdiction. ORG, Ltd. v. Narton Corp., 2007 WL 2234511 at *4 (M.D. Pa. Aug. 1, 2007); Bridgelux, Inc. v.

Cree, Inc., 2007 WL 521237 (N.D. Cal. 2007). The Federal Rules of Civil Procedure are similarly intolerant of such fishing expeditions. See In re I-35W Bridge Collapse Site Inspection, 243 F.R.D. 349, 352 (D. Minn. 2007) (Rule 27, which allows for depositions prior to action being filed, cannot be used to determine whether a cause of action exists.)

This Court previously found that “to the extent the patentee cannot identify where a claim element is present on the accused device, it must state the basis upon which it reasonably inferred that the claimed structure is present.” MTS Sys. Corp. v. Hysitron Inc., No. 06-3853 (MJD/AJB), 2007 WL 2159490 (D. Minn. July 25, 2007), In this case, however, Drent Goebel did not allege any basis upon which it reasonably inferred infringement.

IT IS HEREBY ORDERED that Defendant’s Motion to Dismiss pursuant to Rule 12 (b)(1) of the Federal Rules of Civil Procedure [Doc. No. 10] is GRANTED and the matter dismissed without prejudice.

Date: February 15, 2008

s/Michael J. Davis
Michael J. Davis
United States District Court Judge

UNITED STATES DISTRICT COURT
District of Minnesota

Drent Goebel North America, Inc.
as successor in interest to RDP
Marathon, Inc.

JUDGMENT IN A CIVIL CASE

V.

Case Number: 07-4110 (MJD/AJB)

Precision Press, Inc.

☐ **Jury Verdict.** This action came before the Court for a trial by jury. The issues have been tried and the jury has rendered its verdict.

☒ **Decision by Court.** This action came to trial or hearing before the Court. The issues have been tried or heard and a decision has been rendered.

IT IS ORDERED AND ADJUDGED THAT:

Defendant's Motion to Dismiss pursuant to Rule 12 (b)(1) of the Federal Rules of Civil Procedure [Doc. No. 10] is **GRANTED** and the matter dismissed without prejudice.

February 19, 2008

Date

RICHARD D. SLETTEN, CLERK

s/J. Dunbar Fannemel

(By)

J. Dunbar Fannemel, Deputy Clerk